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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER M. KORS and
JASON STADTHERR

Appeal 2015-002886
Application 12/536,043
Technology Center 2800

Before MICHAEL J. STRAUSS, DANIEL N. FISHMAN, and
JAMES W. DEJMEK, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) of a rejection of claims 7–15.¹ Claims 1–6 were previously cancelled. Br. 2. Oral hearing was requested and scheduled for February 13, 2017, but Appellants waived the requested oral hearing on January 12, 2017. We have jurisdiction under 35 U.S.C. § 6(b).

¹ In this Opinion, we refer to Appellants’ Appeal Brief (“Br.,” filed September 18, 2014), the Final Office Action (“Final Act.,” March 18, 2014), the Examiner’s Answer (“Ans.,” mailed November 20, 2014), and the Specification (“Spec.,” originally filed August 5, 2009 (as amended June 7, 2011 and December 12, 2012)).

We reverse and enter a new ground for rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

THE INVENTION

The invention relates to “a front bumper having a headlamp assembly which controls the position of the bumper.” Spec. ¶ 1. More specifically, “[a] protrusion extending from a bottom side of the headlamp housing engages with a notch formed on the interior surface of the bumper to control the position of the bumper fascia relative to the headlamp housing.” Spec., Abstract.

Claim 7, reproduced below, is illustrative with a disputed limitation in italics:

7. A control device for an automotive vehicle, said control device comprising:

a bumper fascia extending from one side of the vehicle to an opposite side of the vehicle in a vehicle width direction, said bumper fascia having an exterior surface and an interior surface, said interior surface having a flange and a pair of spaced apart walls, said flange extending generally normal from said interior surface, said pair of walls extends outwardly from said flange to define a notch between said pair of walls and said flange, *said flange and said pair of walls being formed integrally as one piece with the bumper fascia*; and

a headlamp housing holding a lens and a lamp unit, said headlamp housing having a protrusion;

said protrusion formed integrally as one piece with a bottom side of said headlamp housing, said protrusion extends from said headlamp housing towards said interior surface of bumper fascia, and said protrusion having a pair of spaced apart side surfaces received within said notch between said pair of walls to connect said headlamp housing and said bumper fascia thereby restraining movement of said bumper fascia in said vehicle width direction.

THE REJECTIONS

Claims 7–11 and 13–15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hoffner et al. (US 2002/0117875 A1; pub. Aug. 29, 2002) (“Hoffner”). Final Act 4–7.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hoffner and Schwab (US 2005/0190573 A1; pub. Sept. 1, 2005). Final Act. 7–8.

ISSUE

Appellants’ arguments present the dispositive issue: Has the Examiner erred by finding Hoffner discloses the above-identified disputed limitation of claim 7?

ANALYSIS

The Anticipation Rejection

The Examiner finds, Hoffner discloses,

said flange 43 and said pair of walls ((see figure 2 where 43A is one wall and 43B combined with 50 formed second wall)) being formed integrally as one piece (pair of walls 43A and 438 combined with 50 and flange 43 are formed integrally as one piece and are an integral part of the bumper fascia) with the bumper fascia (19);

Final Act. 5. The Examiner explains “[i]t has been held that the term ‘integral’ is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).” Ans. 3.

Appellants argue, “as clearly illustrated in the figures and detailed in the specification of the Hoffner reference, the bumper skin 19 is an entirely separate element from the curved bracket 43.” Br. 6.

We are persuaded by Appellants’ argument that the Examiner erred. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Here, although Appellants do not identify where in Hoffner it is clearly illustrated and detailed that its bumper and bracket are *separate* elements, it is the Examiner’s burden to identify where Hoffner expressly or inherently describes that the bumper and bracket (read as the recited fascia and flange, respectively) are “*formed integrally*.” The Examiner has not met that burden. We need not decide whether “integral” and “formed integrally as a one piece” means something different under our broadest reasonable interpretation standard. Regardless, the Examiner has not shown Hoffner discloses (expressly or inherently) that the cited elements of Hoffner (Fig. 2, elements 19, 43, 43A, 43B, 50) are formed integrally, fastened, or welded in any manner.

For the above reason, we do not sustain the Examiner’s rejection of independent claim 7 or claims 8–11 and 13–15, dependent therefrom.

The Obviousness Rejection

Claim 12 depends from claim 7 and is rejected as obvious over the combined teachings of Hoffner and Schwab. The Examiner does not rely on Schwab to cure the above-identified deficiency of Hoffner and, thus, we do not sustain the rejection of claim 12 for the same reason as claim 7.

Appellants raise additional issues in the Brief. We are persuaded of error with regard to the identified issue discussed *supra*, which is dispositive as to the rejection of all claims. Therefore, we do not reach the additional issues.

NEW GROUNDS OF REJECTION UNDER 37 C.F.R. § 41.50(b)
CLAIMS 7–15 REJECTED UNDER § 112, FIRST PARAGRAPH

The Specification must contain a written description of the invention and the manner of making and using it. 35 U.S.C. § 112, first paragraph. The test for written description is summarized in *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (internal quotation marks and citations omitted):

In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *haec verba* support for the claimed subject matter at issue Nonetheless, the disclosure must . . . convey with reasonable clarity to those skilled in the art that . . . [the inventor] was in possession of the invention Put another way, one skilled in the art, reading the original disclosure, must immediately discern the limitation at issue in the claims That inquiry is a factual one and must be assessed on a case-by-case basis.

Claim 7 recites, *inter alia*, “said flange and said pair of walls being formed integrally as one piece with the bumper fascia.” We find no disclosure of this feature in Appellants’ Specification. In Appellants’ Appeal Brief, the Summary of Claimed Subject Matter section alleges this feature is supported by Figures 1, 2, 5, and 8. Br. 3. Appellants do not identify specific aspects of these figures that allegedly support this feature

and we discern no support therefor. In particular, we note the disputed limitation refers to the manner in which these various elements are “formed.” Presuming “formed” to mean the manner in which these elements are manufactured as a single integral piece or in some other manner joined into one integral component,² we find no supporting disclosure in the original Specification, and Appellants have failed to identify in its Appeal Brief support, with any specificity, to describe how the elements are so formed.

Appellants specifically amended the paragraph 28 of the Specification (June 7, 2011) to recite that, in the headlamp assembly, “protrusion 36 is formed integrally as one piece with a bottom side 38 of the headlamp housing 28.”³ Thus, Appellants recognized lack of explicit support for a similar feature relating to the headlamp assembly but did not add any similar support for this disputed limitation relating to the integral formation of the flange, the walls, and the bumper fascia.

For the above reasons, we find independent claim 7 fails to comply with the written description requirement of 35 U.S.C. § 112, first paragraph (pre-AIA). Claims 8–15 depend from claim 7 are rejected for the same reason as they incorporate this same deficiency by virtue of their dependency.

² Should this Application proceed in further prosecution, we suggest the Examiner consider whether “formed integrally as one piece” has a sufficiently definite meaning under 35 U.S.C. § 112, second paragraph.

³ Should this Application proceed in further prosecution, we suggest the Examiner consider whether this amendment was adequately supported by the original Specification or, instead, should have been objected to as new matter.

DECISION

For the above reasons, we reverse the Examiner's decision rejecting claims 7–15.

We enter a new ground of rejection for claims 7–15 under 35 U.S.C. § 112, first paragraph (pre-AIA) for failing to comply with the written description requirement.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

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Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)